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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/055,648	01/23/2002	Ryuji Nakata	F-7282	9422
28107	7590	01/05/2004		
JORDAN AND HAMBURG LLP 122 EAST 42ND STREET SUITE 4000 NEW YORK, NY 10168			EXAMINER JOHNSON, JERRY D	
			ART UNIT 1764	PAPER NUMBER

DATE MAILED: 01/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/055,648	Applicant(s) NAKATA, RYUJI	
	Examiner Jerry D. Johnson	Art Unit 1764	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baile et al., Davis et al., U.S. Patents 3,729,415; 3,547,819; 3,541,011 and Rumierz, U.S. Patent 4,146,487 in view of Takata et al.

Baile et al., U.S. Patent 4,492,415, teach roller bearings wherein the matrix of the bearing component is composed of a solid, tough, elastic gel comprising lubricating oil and a high molecular weight polymer (column 3, lines 20-30). The lubricating matrix can be produced by any means known to the art so long as it has sufficient mechanical strength and the ability to release sufficient lubricant for the intended application (column 6, lines 19-22). Preferred lubricating matrices are disclosed in the patents to Davis et al. and Rumierz. Those patents are incorporated by reference by Baile et al. (column 6, lines 22-40). Conventional lubricating additives such as nylon or Teflon powder and molybdenum disulfide may also be incorporated in the matrix in known manner (e.g., Baile et al., column 8, lines 37-40; Davis et al., U.S. Patent 3,729,415, column 7, lines 27-29).

Takata et al., U.S. Patent 6,020,290, disclose grease compositions for rolling bearings containing 0.05 to 10 parts by weight zinc dithiocarbamate (abstract). Other conventional additives disclosed include zinc dithiophosphate and organic molybdenum extreme pressure agents (column 6, lines 27-39).

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It would have been obvious to one having ordinary skill in the art at the time the invention was made to include a conventional extreme pressure and/or antiwear additive, wherein said additive is a “phosphate or carbamate in organometallic complexes and in which the metal is Zn or Mo”, in the lubricant composition of Baile et al. in order to improved the extreme pressure and/or antiwear properties of said composition. Furthermore, it would have been obvious and well within the ability of the skilled artisan to determine the optimum amounts of said known lubricant additives to achieve their recognized desired effects on lubricants. Cf. *In re Aller*, 220 F.2d 454, 105 USPQ 233 (CCPA 1955); *In re Luck*, 476 F.2d 650, 177 USPQ 523 (CCPA 1973); *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Applicant's arguments filed October 3, 2003, to the extent they are applicable to the instant grounds of rejection, have been fully considered but they are not persuasive.

Applicant argues

applicant invented the meticulous balancing of the parameters and selection of materials necessary to achieve simulataneously [sic] a multiplicity of advantageous effects. This was far beyond mere optimization obvious to one of ordinary skill in the art. (Remarks, page 6).

Applicant's argument lacks merit.

There is no evidence of record that the claimed “parameters and selection of materials” provide unexpected results when compared against the applied prior art. Attorneys arguments unsupported by factual evidence do not take the place of objective evidence of unobviousness. *In re Lindner*, 173 USPQ 356.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

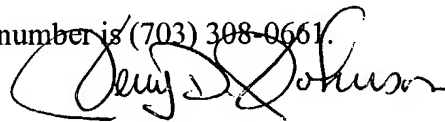
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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerry D. Johnson whose telephone number is (703) 308-2515. The examiner can normally be reached on 6:00-3:30, M-F, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Caldarola can be reached on (703) 308-6824. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-5408.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Jerry D. Johnson
Primary Examiner
Art Unit 1764

JDJ